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## REMARKS

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Claims 1-61 are currently pending. Claim 8 has been rewritten. No claims have been added or cancelled.

Applicants do not believe that any fees are due at this time; however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to this document, the

10 Commissioner is authorized to deduct the fees from Ian F. Burns & Associates, P.C. Deposit Account No. 50-0913.

### I. ALLOWABLE SUBJECT MATTER

Applicants note with appreciation the allowance of claims 13-30 and 40-61.

### 15 II. REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 8-11 were rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite for the term "the primary gaming device" lacking antecedent basis. Claim 8 has been rewritten. Applicants believe claims 8-11 comply with §112 and respectfully request the §112, second paragraph, rejection of claims 8-11 be withdrawn.

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### III. REJECTION UNDER 35 U.S.C. §103(a)

Claims 1-12 and 31-39 were rejected over at least Great British patent GB216937A to Orr (hereinafter, "Orr") in view of U.S. patent 6,315,664 to Baerlocher et al. (hereinafter, "Baerlocher"). Before discussing Orr and Baerlocher, Applicants would like to refresh the  
25 Office's understanding of certain aspects of their invention.

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In certain embodiments, Applicants' invention is directed to apparatus and methods for awarding bonus prizes. For example, Applicants disclose a bonus game that generates and displays at least one outcome, the bonus game including two possible symbols that may be displayed and that determine the outcome. *See* page 7, lines 2-23. This embodiment is

5 illustrated by Applicants as one or more spinning coins having a first and second side, each side bearing a different symbol; for example, "heads" or "tails." *See id.* The game outcome is determined by which symbol or symbols are displayed to the player. *See id.*

#### Orr

Orr provides a very brief, and somewhat difficult to parse, description of what appears to  
10 be a "supplementary" game to a main "gaming machine." *See* page 1, lines 5-11. The game suggested by Orr appears to be a color guessing game based on the color of a number of cards. *See id.* at 32-57. For example, two cards may be displayed that each may be red or black. *See id.* The player may be allowed to guess before hand that both cards will be red or that both cards will be black. *See id.* at lines 39-41. However, there are actually three combinations that may  
15 result from the game: all black cards, all red cards, or mixed red and black cards. *See id.* at lines 35-37. It does not appear that the player is allowed to choose a "mixed" result.

It appears that, during the supplemental game, the player is allowed to "bet" on the outcome of the supplemental game. *See id.* at lines 12-18 and 27-31. The player apparently may lose something of value if the bet is unsuccessful. If the player's bet is successful, the player  
20 goes on to play additional game rounds where the player is given more or less alternatives to choose from. *See id.* at lines 12-18 and 48-72.

Orr does not appear to meet Applicants' claims for at least two reasons. First, Orr does not teach "two possible symbols" because Orr actually discloses at least three "symbols" that may determine the game outcome-all black cards, all red cards, or a mix of black and red cards.

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Secondly, and similarly, Orr does not teach a bonus game where “each outcome [is] determined by the symbol that is displayed.” *See* claim 1. The outcome of Orr appears to be determined by a combination of symbols, not a single symbol as in Applicants’ claims.

Baerlocher

5 Baerlocher was cited for allegedly teaching a predefined payout based on the number of similar binary outcomes displayed. However, Applicants respectfully disagree with the Office’s characterization of Baerlocher. It appears that Baerlocher purports to suggest allowing a player to pick from a plurality of indicators, where the indicators are success indicators or failure indicators. *See* column 2, lines 15-34. If the selected indicator indicates failure, the game stops.  
10 *See id.* at lines 55-56. If the selected indicator is a success indicator, the player is awarded a prize and is allowed to choose from additional indicators. *See id.* at lines 49-64.

In Baerlocher, it appears that a player is awarded a prize each time a success indicator is chosen. It appears that the prize is independent of previously or subsequently chosen indicators. Therefore, the prize in Baerlocher does not entitle “a player to a predefined payout **depending**  
15 **on a number of similar outcomes displayed,**” because the value of an indicator does not “depend” on any other indicator.

By contrast, Applicants teach that a prize may depend on the number of similar outcomes displayed in the bonus game. For example, three outcomes may be determined, each by which of two symbols (heads or tails) is displayed on a coin. *See* page 7, lines 2-23. If all three  
20 outcomes are similar (for example, all “heads”), the player may be entitled to a first prize. If two of three outcomes are similar, the player may be entitled to a different prize. *See id.* at lines 22-24. Again, it is the combination of the outcomes in Applicants’ invention that determines whether the player gets a prize, and what prize the player receives, whereas each prize in Baerlocher appears to be independent.

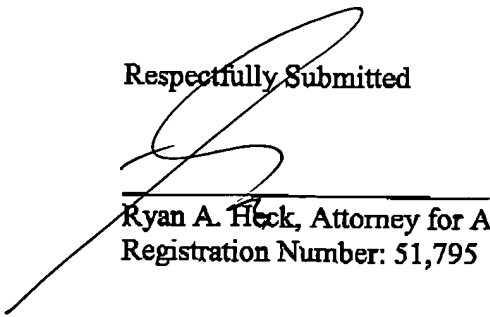
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Because neither Orr, Baerlocher, nor their combination teaches all elements of Applicants' claims, Applicants respectfully assert that claims 1, 5-7, 12, 31, 35-36, and 39 are patentable over Baerlocher and Orr. Because the independent claims are patentable over the cited art, dependent claims 2-4, 8-11, 32-34, and 37-38 are patentable over Baerlocher, Orr, and 5 U.S. patent 5,154,420 to Gutknecht. Accordingly, Applicants respectfully request the §103(a) rejections of claims 1-12 and 31-39 to be withdrawn.

### CONCLUSION

For all of the above reasons, the Applicants submit that the present application is in 10 condition for allowance. If the Examiner has any questions regarding the application or this response, the Examiner is encouraged to call Applicants' attorney, Ryan A. Heck, at (775) 826-6160.

15 Respectfully Submitted

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October 14, 2003